



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,911	12/06/2001	Mark C. Waterbury	01241	7218

20879 7590 05/15/2003

EMCH, SCHAFFER, SCHAUER & PORCELLO CO
P O BOX 916
ONE SEAGATE SUITE 1980
TOLEDO, OH 43697

[REDACTED] EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 05/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

53

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE - 3 - MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- Responsive to communication(s) filed on 4/22/03
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- Claim(s) 1 - 22 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- Claim(s) 21 is/are allowed.
- Claim(s) 1, 5-7, 14-20 is/are rejected.
- Claim(s) _____ is/are objected to.
- Claim(s) _____ are subject to restriction or election requirement

Application Papers

- The proposed drawing correction, filed on _____ is approved disapproved.
- The drawing(s) filed on _____ is/are objected to by the Examiner
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- All Some* None of the:
- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received
in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892 Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948 Other _____

Office Action Summary

Art Unit 1771

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The abstract of the disclosure is objected to because particularly in view of applicants' major changes in drafting both their claims and also their specification the Abstract in its present form is not believed to properly disclose the invention to one of ordinary skill in the art. Correction is required. See MPEP § 608.01(b).

3. Claims 1, 5-7, and 14-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Spies et al., substantially for the reasons set forth in paragraph Nos. 10 and 11 of Paper No. 3, together with the following additional observations. With respect to claim 1, as applicants have noted (Response, page 9, second paragraph) Spies et al. discloses adhesives that were based on acrylic acid, which is taught as particularly suitable, e.g. specification, page 8, for the repulpable adhesive composition. As such it clearly reads upon applicants' claim 1 limitation that the adhesive phase ("continuous" is believed to be, if not inherent, an obvious modification to one of ordinary skill) "is at least one organic compound incorporating one or more high polarity functional groups of an acid functionality". Since acrylic acid polymers and copolymers clearly meet this limitation, applicants' traversal is respectfully not understood. With respect to claims 5-7, as was previously set forth the

Art Unit 1771

presence of a water insoluble, discontinuous phase in either the substrate, adhesive layer or "abherent" layer or all three such layers reads upon the presence of a wide variety of well known filler materials. As to claims 14, 15, and 17-20, as was previously set forth these are firmly believed to read upon well known elements such as soluble starches, ionic salts of polyacrylic acid, and water insoluble, discontinuous phase of cellulose fibers or high molecular weight acrylic acids ^{which} are still firmly believed to be well known to one of ordinary skill in the art, a holding which applicants have not contested. As to claim 16, however, which recites that the water dissolvable, continuous phase abherent layer is lecithin, note as state of the art Huber, column 9, lines 43-55, particularly lines 53-55 that lecithin is a well known release agent in the adhesive tape art such as masking tapes. As such, the Examiner must respectfully submit that applicants have failed to prove their burden with respect to dependent claim 16. Other parameters that are not either expressly or inherently disclosed are each still believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

4. Claim 21 is allowed.

5. . Applicants' amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicants are reminded of the extension of time

Art Unit 1771

policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be

Serial No. 10/008,911

-5-

Art Unit 1771

reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

May 6, 2003

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1900
1700

Daniel Zirker